

### **REMARKS/ARGUMENTS**

The official Office Action dated August 12, 2003, has been carefully considered. Claims 1-26 remain in the application. Claims 27-46 have been canceled and will be pursued in subsequent divisional applications. No new matter is believed or intended to be involved. Applicants believe the changes presented herewith, taken with the following remarks, are sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

#### *Election/Restriction*

In Sections 1 and 2 of the Office Action, it was indicated that Applicants elected the species readable on claims 1-26 and that Applicants' election has been treated as an election without traverse. Accordingly claims 27-46 were withdrawn from consideration. Applicants have canceled claims 27-46 and will pursue the invention of claims 27-46 in subsequent divisional applications.

#### *Requirement for Information*

In Sections 3-9 of the Office Action, the Examiner has determined that further information is required for examination of the application. In particular, the Examiner requests the following:

#### *Section 4*

Please provide the names of any products or services that have incorporated the claimed subject matter.

Whirlpool currently offers for sale a refrigerated range under the name Polara<sup>®</sup> Refrigerated Range, which incorporates the claimed subject matter of the present invention. Whirlpool does not offer any services that incorporate the claimed subject matter.

#### *Section 5*

Please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of the elected first species of the instant invention.

Applicants have not authored or co-authored any publication which describes the disclosed subject matter of the elected first species of the instant invention.

#### *Section 6*

Please provide a copy of EP Application No. 02 02 2260 which is the subject of the European Search Report dated April 23, 2003 listed on Information Disclosure Statement filed on June 3, 2003.

A copy of EP Application No. 02 02 226059 (EP 1 302 144 A2 and EP 1 302 144 A3) is enclosed.

#### *Specification*

In Section 10 of the Office Action, the disclosure was objected to because the last sentence of paragraph [0006] does not correctly characterize the Filipowski patent. Applicants have revised paragraph [0006] and eliminated reference to the Filipowski patent. Accordingly, Applicants respectfully request reconsideration and the objection be withdrawn.

*Claim Rejection 35 U.S.C. §102*

In Sections 11 and 12 of the Office Action, claims 1-26 were rejected under 35 U.S.C. §102(a) as being anticipated by Richard Babyak's "Getting Connected: Network News", posted on the Internet on August 16, 2000. The Examiner contends that the article discloses that the instant invention was made public on or before August 16, 2000, by Whirlpool Corporation. Applicants respectfully traverse the rejection.

Independent claim 1 recites:

1. A combination appliance for cooling and cooking a food item, comprising:
  - a frame comprising a cooking chamber and a refrigeration module chamber, and the cooking chamber having a first access opening through which access to the interior of the cooking chamber is provided;
  - a door moveably mounted to the frame for movement between an open position where the first access opening is uncovered and a closed position where the first access opening is covered;
  - a heat element disposed within the cooking chamber to selectively provide heat to the cooking chamber;
  - an inlet duct extending between the refrigeration module chamber and the cooking chamber, the inlet duct having an inlet in communication with the refrigeration module chamber and an outlet in communication with the cooking chamber;
  - a return duct extending between the refrigeration module chamber and the cooking chamber, the return duct having an inlet in communication with the cooking chamber and an outlet in communication with the refrigeration module chamber;
  - a refrigeration module comprising a compressor, condenser, evaporator, and base on which the compressor, condenser, and evaporator are mounted to form a module, and an insulated housing overlying the evaporator to thermally isolate the evaporator from the condenser, the insulated housing having an inlet and an outlet, which align with the outlet of the return duct and the inlet of the inlet duct, respectively, when the refrigeration module is mounted within the refrigeration module chamber, to thereby form a refrigerated air path between the evaporator and the cooking chamber.

The August 16, 2000, Babyak article briefly summarizes an interview given by Whirlpool Corporation. Chairman and CEO David Whitwam on May 17, 2000. A copy of the interview is herewith provided to the Examiner. In that interview, concerning an Internet-enabled combination refrigerator/oven appliance, Mr. Whitwam provided a very brief, undetailed overview of an example of a concept that Whirlpool was pursuing:

"We've talked about by the latter part of this year we'll have a wall oven that's a refrigerator, too. In the morning when the housewife leaves the home, she puts the roast or the casserole in. At the end of the day she can come in through the Internet, and that refrigerator/oven becomes strictly an oven, and will cook the meal. So these are the kinds of things that we think bring value to the consumer."

This was the only statement in any way addressed to the concept of a combination refrigerator/oven appliance. At no time during the interview did Mr. Whitwam provide any details concerning the structure or operation of the combination refrigerator/oven appliance sufficient to constitute a disclosure of the invention claimed in application Serial No. 09/977,775. Mr. Whitwam's statements simply described in the broadest terms the concept of a combination refrigerator/oven appliance that could be remotely operated through an Internet connection. This is insufficient to constitute a disclosure of the invention claimed in application Serial No. 09/977,775 under 35 U.S.C. §102(a) or (b). Nor does the Babyak article provide any details concerning the structure or operation of the combination refrigerator/oven appliance sufficient to constitute a disclosure of the invention claimed in application Serial No. 09/977,775 under 35 U.S.C. §102(a) or (b).

The statement in the Babyak article, implicitly attributed to Mr. Whitwam, that "Prototypes of the novel appliance are currently being tested" is patently incorrect. As the above quoted statement clearly discloses, Mr. Whitwam made no such statement. As Applicants' prior

response filed November 10, 2003, indicates, the first prototypes were tested beginning in about November 2000, which is consistent with Mr. Whitwam's statement that Whirlpool would have a combination refrigerator/oven appliance "by the latter part of this year." There was no testing of a prototype combination refrigerator/oven appliance operable through the Internet prior to November 2000. As well, as Applicants' prior response has indicated, there was no public disclosure of the combination refrigerator/oven appliance operable through the Internet prior to January 2002.

Applicants cannot find any teaching or suggestion in the Richard Babyak article of all the elements, or any of the elements, of the combination appliance for cooling and cooking a food item as defined in independent claim 1. For example, Applicants cannot find any teaching or suggestion of an appliance comprising a frame comprising a cooking chamber and a refrigeration module chamber, and the cooking chamber having a first access opening through which access to the interior of the cooking chamber is provided; a door moveably mounted to the frame for movement between an open position where the first access opening is uncovered and a closed position where the first access opening is covered; a heat element disposed within the cooking chamber to selectively provide heat to the cooking chamber; an inlet duct extending between the refrigeration module chamber and the cooking chamber, the inlet duct having an inlet in communication with the refrigeration module chamber and an outlet in communication with the cooking chamber; a return duct extending between the refrigeration module chamber and the cooking chamber, the return duct having an inlet in communication with the cooking chamber and an outlet in communication with the refrigeration module chamber; and the refrigeration module comprising a compressor, condenser, evaporator, and base on which the compressor, condenser, and evaporator are mounted to form a module, and an insulated housing overlying the

evaporator to thermally isolate the evaporator from the condenser, the insulated housing having an inlet and an outlet, which align with the outlet of the return duct and the inlet of the inlet duct, respectively, when the refrigeration module is mounted within the refrigeration module chamber, to thereby form a refrigerated air path between the evaporator and the cooking chamber as recited in independent claim 1.

In sharp contrast, the Richard Babyak article very simply states that "Whirlpool Corporation Chairman and CEO David Whitwam revealed plans for an internet-enabled combination refrigerator/oven appliance during an interview on CNBC. The idea is that the user would be able to prepare a meal ahead of time, keep it safely cooled, then remote initiate cooking, so that the meal would be ready upon arriving home." Applicants submit that the article reveals plans for a refrigerated/oven appliance, but certainly the article does not provide a level of detail that identifies the structural and functional elements of the combination appliance as defined in independent claim 1.

Anticipation under 35 U.S.C. §102(b) requires the disclosure in a single prior art reference of each of the claims under consideration, *Alco Standard Corp. v. TVA*, 1 U.S.P.Q. 2d 1337, 1341 (Fed. Cir. 1986). In view of the failure of the Babyak article/reference to disclose all the elements as recited in independent claim 1, the Babyak reference does not disclose each element of the claims under consideration and therefore does not anticipate the present claims under 35 U.S.C. §102(b). Moreover, since claims 2-26 depend from and include the same distinctive features of independent claim 1, these claims are also not anticipated by Babyak. It is therefore submitted that the rejection under 35 U.S.C. §102(b) has been overcome. Reconsideration is respectfully requested.

In Sections 13 & 14 of the Office Action, the Examiner raised an issue of public use or sale of the invention and rejected claims 1-26 under 35 U.S.C. §102(b) based on public use or sale of the invention. It is contended that the instant invention was made public by Whirlpool Corporation prior to October 15, 2000, because of Richard Babyak's article posted on the internet on August 16, 2000. However, as will be set forth in detail below and in response to the Examiner's request for more information, Applicants did not make public or offer for sale the invention prior to October 15, 2000. Accordingly, Applicants respectfully traverse this rejection.

Specifically, as previously discussed, Richard Babyak's article does not teach or suggest all the elements of the claimed invention as recited in independent claim 1. Accordingly, Richard Babyak's article cannot be considered public disclosure of the present invention, and the rejection must fail. Applicants also respectfully submit that the claimed invention was held in confidence by Whirlpool Corporation until its first public disclosure January 16-17, 2002 at a public unveiling at a press conference in New York City. Since the instant application was filed after the first public disclosure, and certainly, within one year of public disclosure as defined in 35 U.S.C. §102(b), the application was timely filed. As a result, Applicants respectfully request reconsideration.

With respect to Section 14 of the Office Action, Applicants provide the following information:

- a) On which date did the public announcement relating to the instant invention as cited in Richard Babyak's "Getting Connected: Network News" occur?

The public announcement relating to the present invention occurred on January 16-17, 2002. Whirlpool presented a prototype range to reporters in New York City to

introduce the refrigerated range and provide demonstrations. The prototype range was configured with the necessary structure to achieve all the steps recited in the method of independent claim 1. The reporters were not required to sign confidentiality agreements. No public announcement relating to the instant invention was cited in the Babyak article, as discussed above, nor was any public announcement relating to the instant invention made prior to the Babyak article.

b) Which other public announcements and/or press releases were made in connection with the instant invention? when? and to which audiences?

Applicants are not aware of any other public announcements and/or press releases prior to January 16-17, 2002 other than David Whitwam's very general statement of August 16, 2000 as appeared in Richard Babyak's article. However, following the January 16-17, 2002 public announcement, numerous public announcements, press releases and demonstrations were made to the public which related to the new refrigerated range.

c) When were the prototypes mentioned the Richard Babyak article first assembled?

As discussed above, no prototypes as mentioned the Richard Babyak article existed. The Babyak article references prototypes being tested as of the date of the article, but this statement is inaccurate. Testing of prototypes related to the instant invention began in about November 2000.



When did prototype testing begin?

Applicants made two sets of prototypes which lead to the presently claimed invention. The first set of prototypes consisted of approximately 5-8 units and were originated in about November 2000. These first prototypes were kept in laboratories on Whirlpool premises and used/designed/tested exclusively by Whirlpool engineers and designers.

Who tested the prototypes and how?

All testing for the first group of prototypes occurred in laboratories owned by Whirlpool.

All testing of the second group of prototypes also occurred in the laboratories owned by Whirlpool until about June 2001. In about June 2001, two of the 10-15 prototypes from the second group of prototypes were installed in the homes of two Whirlpool employees, specifically two engineers developing the project for further testing. The two field unit prototypes remained in the homes of the two Whirlpool employees until about July 2001, at which time, they were sent back to Whirlpool laboratories.

How and when were the prototypes disposed of?

Applicants are not sure of the exact timing of the destruction of the prototypes, and are not sure all of the prototypes have been destroyed. However, Applicants believe the destruction of most, if not all, of the units began in August 2001. Applicants believe that if all the prototype units have not been destroyed, the units have been warehoused. Applicants submit they did not sell, offer to sell, publicly use or publicly display any of the prototype units prior to January 16-17, 2002.

d) At which trade shows were prototypes or concept appliances related to the instant invention displayed? When were these trade shows, if any? Was the use of the prototypes or concept appliances demonstrated at the trade shows? Which brochures were made available to the public at the trade shows?

Applicants did not show any prototype or concept appliances at any tradeshow prior to January 16-17, 2002. Applicants also did not make or distribute any brochures prior to January 16-17, 2002.

e) Where else, when, and for which audiences were demonstrations of models or prototypes of the instant invention conducted?

1) Whirlpool generally disclosed the concept of a refrigerated range to the Department of Energy in May 2001 to determine the scope of regulatory issues relating to combining heating and cooling components in a single unit and the inability of the refrigerated oven to meet the energy regulations of refrigerators. Whirlpool did not provide a model, prototype, drawings, demonstration or sufficient description to describe all the functional and structural elements of the recited invention to the Department of Energy. Accordingly, Applicants believe the disclosure to the Department of Energy cannot be a public disclosure under 35 U.S.C. 102.

2) Whirlpool may have conducted one-on-one interviews with consumers in about October 2001 to discuss the refrigerated oven. Whirlpool believes that if it had conducted such interviews, the interviews would have been conducted under terms of

confidentiality. However, Whirlpool, cannot, at this time, find copies of signed confidentiality agreements.

Nonetheless, if any interviews were conducted in October 2001 and were not under the terms of confidentiality the interviews would not be a bar to patentability as the disclosure did not occur more than one year prior to the date of the application as defined in 35 U.S.C. §102(b).

For the reasons presented above, it is believed that the application, as now presented, is in condition for allowance, and that there are no remaining issues in the application. Allowance of the application as now presented, and passing of the application to issue are respectfully solicited.

The clarification herein of the points made in the Babyak article, and the submittal of a copy of the interview referenced therein, is believed to constitute a full, direct, and clear response to the questions submitted by the Examiner in the August 12, 2003, and February 2, 2004, Office Actions, and to resolve all outstanding issues concerning Applicants' November 10, 2003, response. If for any reason the Examiner feels that this amendment does not so place the application in condition for allowance, it is respectfully requested that she promptly contact applicants undersigned attorney by telephone at the number shown below so that suitable steps may be taken to place the application in such condition.

Further and favorable action is respectfully requested.

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Examiner: Lilijana V. Ciric  
Group Art Unit: 3753

Respectfully submitted,

MUELLER ET AL.

Dated: 3/2/04

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